

AUG 14 2007

Application No. 10/716,586
Office Action of February 14, 2007

182531-0004

Remarks/Arguments:

In response to the Office Action, applicant offers the following remarks and substantive argument. Claims 1 through 16 are pending in this application, and currently stand as rejected from allowance. Applicant has substantively amended claims 1, 2, 5, and 6 to overcome the cited bases for rejection.

Rejections under 35 U.S.C. §§ 102 and 103

The Office Action rejected claim 1 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 4,538,827 ("Plifka"). The Office Action also rejected claims 2 through 8 under 35 U.S.C. § 103(a) as being unpatentable over Plifka in combination with U.S. Patent No. 3,736,016 ("Garvey"), or U.S. Patent No. 4,811,578 ("Masoncup et al."), or U.S. Patent No. 4,380,160 ("Hoffman"), and / or one or more other U.S. patents. The Office Action further rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Plifka in combination with Hoffman. The Office Action rejected claims 9 and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,473,001 ("White") in combination with Garvey and Plifka or other U.S. patents. Finally, the Office Action rejected claims 10, 11, 12, 13, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over White in combination with U.S. Patent No. 6,463,769 ("Garner") and Plifka or other U.S. patents.

In view of the newly cited Plifka reference, applicant has substantively amended claims 1, 2, 5 and 6.

- Claims 1 and 2 Recite Patentable Subject Matter

As amended, claim 1 recites:

A protective cover for use with a locking device, said protective cover comprising:
a channel shaped protective shroud sized to cover at least part of the locking device,
said protective shroud having openings at two opposite ends of the shroud;
means to affix the protective shroud to an access door in place over the locking
device; and

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a single hasp element having a notch which extends through the access door and into which the locking device engages under the protective cover, such that upon locking the locking device to the single hasp element, the locking device can not be removed from the single hasp element unless the locking device is unlocked.

(Emphasis added).

As amended, claim 2 recites a similar limitation:

A protective cover for use with a locking device, said protective cover comprising:

a channel shaped protective shroud sized to cover at least part of the locking device, said protective shroud having openings at two opposite ends of the shroud;

a plurality of anchors attached to the protective shroud;

means to affix the protective shroud to an access door in place over the locking device; and

a single hasp element having a notch which extends through the access door into which the locking device engages under the protective cover, such that upon locking the locking device to the single hasp element, the locking device can not be removed from the single hasp element unless the locking device is unlocked.

(Emphasis added).

Claims 1 and 2 now specifically relate to and teach a protective cover to be used with a locking device where the protective cover, or protective shroud is attach to an access door. In a similar fashion, independent claims 9 and 16 also include the limitation that the protective shroud is affixed to or attached to an access door. The specific support for this limitation is provided throughout the original filed application specification, but more specifically is shown at page 7, lines 11 through 16 noting that the "apparatus has three primary components to allow use with a locking device and to secure unauthorized opening of an *access door*. The components include a protective cover or shroud, as shown in Fig. 1, means to rigidly affix the protective shroud to an *access door*, and a hasp element located under the protective cover and to which a locking device locks."

(Emphasis added). The access door is also shown in Figs. 3, 4 and 6.

Applicant notes that Plifka and Hoffman, two of the primary patents cited as support for rejection of the pending claims, are both designed to be used with tow bars, tow rings, and / or trailer hitches. The described and disclosed inventions and embodiments in Plifka and Hoffman do

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not show any type of access door. Indeed, there is no suggestion or disclosure in either Plifka or Hoffman that a cover, such as the Hoffman cover 58, or the Plifka housing 28, is to be affixed to, attached to, or used with any access door. Moreover, a review of White shows that there is no suggestion or disclosure, or any motivation to include any type of cover or protection of the padlock 13 shown. White merely discloses a lock for a switch box where the switch box has a body portion 1 and a cover 2 that is hinged to the body portion.

Section 103 precludes a patent "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art" (emphasis added). The "as a whole" instruction in Section 103 prevents evaluation of the invention part by part. "Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result--often the very definition of invention." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004); *see also Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). As also recently explained by the U.S. Supreme Court and previously by the U.S. Court of Appeals for the Federal Circuit, the use of hindsight bias is not appropriate. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007); *In re Kamm*, 452 F.2d 1052, 1056-57 (CCPA 1972) (improper to pick and choose the claimed elements from among the various prior art references using the patent as a blueprint).

The mere fact that the White patent shows use of a padlock with a box cover provides no basis to suggest any combination, let alone an obvious combination with any other separate patent having a cover over the box or lock. The combination, through the use of hindsight, of White with Plifka or Hoffman has no suggestion or motivation when considered either independently or as a whole. The pending claims as amended, and narrowed specifically to application with access doors is a distinct invention that is not anticipated or rendered obvious in view of Plifka alone, or in combination with White or Hoffman.

Further, in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007), the U.S. Supreme Court relied upon "the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more

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likely to be nonobvious." Thus, as "a useful general rule," a "reference that 'teaches away' can not create a *prima facie* case of obviousness." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *see also In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (reversing obviousness determination of the Board in a design patent case because the prior art teaches away from the claimed design) ("A *prima facie* case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention"). When a reference teaches away from the invention, an artisan could not be expected to combine it with another reference.

In that regard, as previously noted, the Hoffman cover 58 and tongue 30 do not provide a close fit for the padlock 50. The padlock 50 has substantial freedom to move even when in a locked configuration. The allowable movement and play of the Hoffman padlock appears to be the reason that Hoffman discloses holes 46 and 62 within tongue 30. Indeed, Hoffman would not be functional using a notch because the padlock 50 would simply fall away from the hasp even in a locked configuration. Applicant sees no suggestion or motivation in Hoffman to have the locking device tongue 30 with a notch as compared to the holes taught and disclosed. More accurately interpreted, the Hoffman design, with the allowable movement for the padlock specifically teaches away from the tongue 30 having a notch rather than holes 46 and 62.

Similarly, the Garner hasp 36, and the Garvey et al. hasp plate 30 both also only disclose use of holes within the hasp element, and do not show a notch element. Similar to Hoffman, both the Garner and Garvey et al. designs allow the lock (40 for both Garner and Garvey et al.) to have substantial movement and "play" even when the lock is in a locked or closed configuration. There does not appear to be any suggestion or motivation in Garner or Garvey et al. to use a notch in the hasp element instead of a hole. In all three of these references, Hoffman, Garner and Garvey et al., the hasp element has a hole (or more than one hole) provided therein so that the padlock is held in place and can not be removed from the hasp.

The Supreme Court, in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007), rejected a rigid application of the requirement that some teaching, suggestion, or motivation ("TSM") be proven before prior art references could be combined. At the same time, however, the Court acknowledged that the TSM test "captured a helpful insight[:] . . . a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Thus, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon

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building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741.

Accordingly, applicant respectfully contends that the advantages disclosed by independent claims 1, 2, 9 and 16 are not attained or suggested by the Plifka, Hoffman, Garvey et al., and/or Garner references. This is because claims 1, 2, 9 and 16 contain features as described above that are not taught or suggested by the applied references. As explained by Judge Rich in *In re Civitello*, 144 USPQ 10, 12 (CCPA 1964), when a claimed feature is not disclosed by the reference, the reference cannot render the claim obvious:

Since Haslacher fails to disclose the feature of the claim relied on, we do not agree with the patent office that it would suggest modifying the Craig bag to contain the feature. The Patent Office finds the suggestion, only after making a modification which is not suggested, as we see it, by anything other than appellant's own disclosure. This is hindsight reconstruction. It does not establish obviousness. (Emphasis in original.)

Thus, Applicant respectfully does not agree with the Examiner that the Plifka, Hoffman, Garvey et al., and/or Garner references, alone or in combination with other references support a *prima facie* case of anticipation or obviousness over the claims as amended.

Dependent Claims

Because claims 3 through 8, and claims 10, 11, 12, 14, and 15 depend directly from a patentable claim, these dependent claims are also patentable. *See, e.g., In re McCarn*, 101 USPQ 411, 413 (CCPA 1954) ("sound law" requires allowance of dependent claims when their antecedent claims are allowed). Moreover, claims 3 through 8, and claims 10, 11, 12, 14, and 15 are each non-obvious in view of the applied references.

Drawings Replacement

Applicant respectfully advises that formal replacement drawings as requested by the Office Action have been commissioned and will be submitted under separate cover. Applicant further notes that reference numeral 18, previously included in replacement drawing Fig. 2, has been specifically included in a replacement paragraph in the application specification.

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Specification Amendment

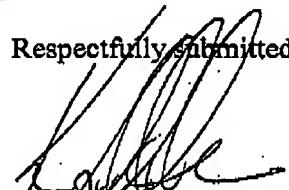
As provided above, applicant has amended the specification to particularly refer to and cite to the epoxy adhesive 18, thereby showing to what reference numeral 18 refers. Applicant respectfully believes this amendment resolves the informality noted in the Office Action.

Conclusion:

By this Amendment, pending claims 1 through 12, and 14, 15, and 16 have been amended directly (or indirectly through an amendment to an independent claim) to place the application in better condition for examination and allowance. The rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) should be withdrawn. Favorable action is earnestly solicited.

Further, the Examiner is invited to call the applicant's undersigned representative if any further action will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present Response. In fact, if the claims of the application are not believed to be in full condition for allowance, for any reason, the applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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KWG:kak:lk

Dated: August 14, 2007

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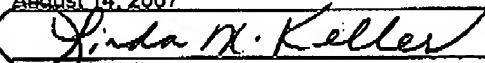
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The Commissioner for Patents is hereby authorized to charge payment for any additional fee which may be required or to credit any overpayment to Deposit Account No. 502951.

Any response in this application requiring a petition for extension of time, but failing to include one, should be treated as though it does include the required petition for extension of time.

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300) on:

August 14, 2007


Linda M. Keller

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PAGE 17/17 * RCVD AT 8/14/2007 3:20:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/6 * DNI:2738300 * CSID:6106401965 * DURATION (mm:ss):08-10